ADDITIONAL FEE:

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R E M A R K S

The Office Action issued February 22, 2006 has been received and its contents have been carefully considered.

Independent claims 1 and 14 have been amended to recite that the "second transport direction (T4, R4) is in two opposing directions." This amendment is supported by Fig. 1, for example, wherein the direction T4 is shown by a left directed arrow and the direction R4 is shown by a right directed arrow.

The provisional allowance of claims 8-13 is noted with appreciation.

Applicant's independent claims 1 and 14 stand rejected under 35 USC §103(a) as being unpatentable over the published European Patent Application No. EP 0 924 558 to Sukita et al. in view of the U.S. Patent Publication No. US 2002/0057457 to Nozaki et al. This rejection is respectfully traversed because a combination of Sukita et al. and Nozaki et al. would not result in the present invention, as claimed.

The European Patent Application of Sukita et al. is discussed with some detail in the "Background of the Invention" portion of this application. Quoted below is an excerpt which appears on page 2, line 21 to page 3, line 6, of this application:

> "Transport of the entire photosensitive material located in the printer [of Sukita et al.] is consistently in the same direction, that is, either from the marking means in the direction of the output unit, or conversely, from the output unit in the direction of the marking means. Due to the return transport of the photosensitive material, it is, therefore, possible to keep the consumption of the unused material after the interruption for providing the image data to a minimum. However, the design of the transport mechanism of the printer [of Sukita et al.] is very elaborate."

Applicant has substantially simplified the transport mechanism of a printer of this type by controlling the transport device which transports the recording material in the marking means independently of the transport device which transports the recording material through the output unit which records the image. Therefore, the two transport devices do not have to be operated in synchronism. Consequently, the transport device in the region of the marking means does not require a reversible drive, as in the case with Sukita et al. (see page 4, line 22 to page 5, line 4 of the application).

Claims 1 and 14 have been amended to make clear that the recording material is driven through the output unit not only in the forward direction T4 but also, intermittently, in the rearward direction R4. This amendment is being made to clearly demarcate the present invention over Nozaki et al.

The patent publication of Nozaki et al. discloses image recording apparatus, of the general type to which the present invention relates, wherein images may be exposed onto recording material 3 at one of two printing stations: a projecting and exposing station 20 and a CRT printer 31. The recording material 3 is moved forward through the apparatus by means of two transport mechanisms: a motor 84 that drives a roller 81 and a motor 85 that drives a pair of rollers 83. Roller 82 is apparently free to roll independently due to the movement of the recording material.

The two drive motors 84 and 85 are independently driven by a controller 100. A loop 40 of recording material accommodates differences in the drive movement.

A careful review of Nozaki et al. will reveal that the recording apparatus there disclosed operates in a completely different manner than that of Sukita et al. In particular, the recording material 3 is driven through the machine in

only the forward direction. While the two transport means do not operate in synchronism with each other, they consistently move the recording material forward from the magazine 4 to the developing station 50. The double arrows at the exposing station 20 apply only to the paper mask 26 for setting the exposure area on the recording material.

Consequently, there would be no motivation for a person skilled in the art to combine the teaching of Nozaki et al. with that of Suikta et al. A transport mechanism, wherein two transport means are driven independently but in the forward direction only, would not result in the recording apparatus or method recited in applicant's claims 1 and 14, respectively.

The case law is quite clear that the mere existence of various elements of an invention in diverse references is not sufficient to render the invention obvious. As stated by the Court of Appeals for the Federal Circuit in Environmental Designs, Ltd. v. Union Oil of Cal., 218 USPQ 865, 870 (1983):

> "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art."

On several occasions the Court of Customs and Patent Appeals has discussed the conditions that must be met to properly combine references in rejecting a claimed invention as being "obvious". As stated in In re Imperato, 179 USPQ 730, 732 (1973):

> "With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references". [Emphasis in original]

Similarly, as stated by the Patent and Trademark Office Board of Appeals in Ex parte Shepard and Gushue, 188 USPQ 536, 538 (1974):

> "The mere fact each reference discloses some particular claimed elements is not sufficient for obviousness without some direction from the prior art."

Similarly, as stated by the Court of Customs and Patent Appeals in In re Regel, Buchel and Plempel, 188 USPQ 136, 139 (1975):

> "As we have stated in the past, there must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references. In re Stemniski, supra. Further, as we stated in In re Bergel, 48 CCPA 1102, 1105, 292 F.2d 955, 956, 130 USPQ 206, 208 (1961):

> 'The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.'"

Similarly, as stated by the Court of Customs and Patent Appeals in In re Skoll, 187 USPQ 481, 483-4 (1975):

> "We agree with appellant that the general rule applicable to a rejection based on a combination of references was stated by this court in In re Shaffer, 43 CCPA 758, 761-62 229 F.2d 476, 479, 108 USPQ 326, 328-29 (1956):
>
> > '[R]references may be combined for the purpose of showing that a claim is unpatentable. However, they may not be combined indiscriminately and to determine whether the combination of references is proper, the following criterion is often used: Namely, whether the prior art suggests doing what an applicant has done * * *. [I]t is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done.'" (emphasis supplied)

In each instance, the holding is that obviousness is not found merely because references could be combined to achieve a claimed invention. For an obviousness rejection to be proper under Section 103 of the Patent Statute, the combination must at least be suggested by the references.

As noted above, independent claims 1 and 14 have been amended to particularly recite that the second transport

means is operated in two opposing directions, providing a clear line of distinction over Nozaki et al.

It is believed, therefore, that claims 1 and 14, as well as all the remaining claims of this application which are dependent thereon, distinguish patetably over Sukita et al. and Nozaki et al., taken either individually or in combination.

The allowance of this application is accordingly respectfully solicited.

Respectfully submitted,

By _____
Karl F. Milde, Jr.
Reg. No. 24,822

MILDE & HOFFBERG, LLP
10 Bank Street - Suite 460
White Plains, NY 10606

(914) 949-3100

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MAY 16, 2006
MILDE & HOFFBERG, LLP

By _____

Date MAY 16, 2006